



IPW

PATENT
Customer No. 22,852
Attorney Docket No. 7883.0080-12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Mark KNUDSON et al.)
) Group Art Unit: 3762
Application No.: 10/682,067)
) Examiner: Unknown
Filed: October 9, 2003)
)
For: METHOD AND APPARATUS FOR)
PERFORMING CORONARY ARTERY)
BYPASS SURGERY)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION RESCINDING REQUEST FOR INTERFERENCE

In a Preliminary Amendment filed with this application on October 9, 2003, Applicants copied claims 1, 3-6, 11, and 12 of U.S. Patent No. 6,290,728 (the '728 patent) as claims 16-22 of this application. Subsequently, and as fully explained in a Disclaimer filed on July 20, 2004 in the '728 patent, the '728 patent and this application became commonly assigned. A copy of the as-filed Disclaimer is provided herewith. By that Disclaimer, claims 1, 3-6, 11, and 12 of the '728 patent, the same claims copied in this application, have been disclaimed. Accordingly, Applicants no longer request an interference with the '728 patent. The circumstances surrounding the Disclaimer are set forth in the Disclaimer and are incorporated in their entirety by reference herein.

Dated: July 20, 2004

By: _____

Michael W. Kim
Reg. No. 51,880



PATENT
Customer No. 22,852
Attorney Docket No. 7883.0008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 6,290,728 B1)
Inventor: David Y. PHELPS et al.)
Issued: September 18, 2001)
For: DESIGNS FOR LEFT)
VENTRICULAR CONDUIT)

Mail Stop Post Issue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DISCLAIMER

Sir:

Percardia, Inc. ("Assignee"), duly organized under the laws of the State of Delaware and having its principal place of business at 10 Al Paul Lane, Suite 202, Merrimack, New Hampshire 03054, through its attorneys, represents that it is the assignee of the entire right, title, and interest in and to the above-identified patent, U.S. Patent No. 6,290,728 B1, which issued on September 18, 2001 from U.S. Patent Application No. 09/369,048, filed August 4, 1999, for DESIGNS FOR LEFT VENTRICULAR CONDUIT, as indicated by assignment duly recorded in the United States Patent and Trademark Office at Reel 10580, Frame 0715.

Assignee, in accordance with the provisions of 37 C.F.R. §1.321(a), hereby disclaims the entirety of claims 1, 3, 4, 5, 6, 11, and 12 of U.S. Patent No. 6,290,728 B1. The circumstances under which this disclaimer is being filed are as follows.

Assignee, through its attorney, also represents that it is the assignee of the entire right, title, and interest in and to U.S. Patent Application No. 10/682,067, filed October 9, 2003, for METHOD AND APPARATUS FOR PERFORMING CORONARY ARTERY BYPASS SURGERY, as indicated by the following three Assignments evidencing a chain of title from the inventors to Assignee, Percardia, Inc.:

1. From: Mark B. Knudson and William L. Giese

To: Heartstent, LLC

The Assignment document was recorded in a parent application (Serial No. 08/882,397) in the Patent and Trademark Office at Reel 8632, Frame 0153.

2. From: Heartstent, LLC

To: HeartStent Corporation

The Assignment document was recorded in a parent application (Serial No. 08/882,397) in the Patent and Trademark Office at Reel 8752, Frame 0342.

3. From: HeartStent Corporation

To: Percardia, Inc.

A copy of the Assignment document with its Patent Schedule is attached. A copy of the document was submitted in U.S. Patent Application No. 10/682,067 for recordation in the U.S. Patent and Trademark Office on February 9, 2004. A reel and frame number has not been received. Application No. 10/682,067 is not listed in the Patent Schedule of the attached Assignment. However, because this application is a continuation application of 10/245,556, which is listed in the Patent Schedule, and the Assignment assigns all continuations of applications listed in the Patent Schedule from HeartStent Corporation to Percardia, Inc., this application was also assigned from HeartStent Corporation to Percardia, Inc.

U.S. Patent No. 6,290,728 hereinafter will be referred to as "the '728 patent," and U.S. Patent Application No. 10/682,067 hereinafter will be referred to as "the '067 application."

On September 18, 2001, the '728 patent issued to Assignee. On October 9, 2003, HeartStent Corporation filed the '067 application with a Preliminary Amendment that copied claims 1, 3, 4, 5, 6, 11, and 12 of the '728 patent as new claims 16-22 of the '067 application. (The '067 application is a continuation of U.S. Patent Application No. 10/245,556, filed September 17, 2002, now abandoned, and which also copied those claims of the '728 patent). Subsequently, by the third-listed Assignment identified above and enclosed with this filing, HeartStent Corporation assigned the '067 application to Assignee, Percardia, Inc. Accordingly, Assignee became the only assignee of the entire right, title, and interest in and to both the '728 patent and the '067 application.

Assignee has reviewed the respective invention dates of claims 1, 3, 4, 5, 6, 11, and 12 of the '728 patent and claims 16-22 of the '067 application, and determined that the inventors named in the '067 application are the first inventors of that claimed subject matter. Accordingly, for this reason, Assignee hereby disclaims the entirety of claims 1, 3, 4, 5, 6, 11, and 12 of the '728 patent.

In making the above disclaimer, Assignee does not disclaim any other portion or claims of the '728 patent, and does not disclaim the right to pursue the subject matter of

claims 1, 3, 4, 5, 6, 11, and 12 in other applications, for example, the '067 application or any other application owned by Assignee.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required small entity fee of \$55.00 is being filed with this Disclaimer.


If a check for the required fee is not filed concurrently herewith or if there are any additional fees due in connection with the filing of this Disclaimer, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 20, 2004

By: _____


Leslie I. Bookoff
Reg. No. 38,084

ASSIGNMENT

WHEREAS, HeartStent Corporation, a Minnesota corporation ("HeartStent"), owns, by assignment, all right, title, and interest in the patents and patent applications listed on the Patent Schedule attached to this Assignment (the "Patents and Patent Applications") and any inventions disclosed and/or claimed therein (the "Inventions"); and

Percardia Inc., a Delaware corporation ("Percardia"), desires to own HeartStent's entire right, title, and interest in and to the Patents and Patent Applications and the Inventions, in all countries throughout the world.

NOW THEREFORE, be it known that, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, HeartStent hereby sells, assigns, transfers, and sets over to Percardia, its lawful successors and assigns, HeartStent's entire right, title, and interest in and to the Patents and Patent Applications and the Inventions; any other U.S. and foreign patents and patent applications directed to any of the Inventions, including without limitation any divisional, continuation, and continuation-in-part; all reissues, reexaminations, renewals, extensions, and foreign equivalents of any of the foregoing; and all rights to claim priority on the basis of any of the above. The parties agree that the rights conveyed hereunder are to be held and enjoyed by Percardia, its successors and assigns, as fully as the same would have been held and enjoyed by HeartStent had this assignment not been made, and HeartStent hereby authorizes and requests the Commissioner of Patents and Trademarks of the United States and any official of any foreign country whose duty it is to issue patents on

applications as described above, to issue all patents for any of the Inventions to Percardia, its successors and assigns, in accordance with the terms of this Assignment.

AND, HeartStent HEREBY further covenants that it has the full right to convey the interest assigned by this Assignment, and it has not executed and will not execute any agreement in conflict with this Assignment.

Execution Copy

IN TESTIMONY WHEREOF, each party has caused its authorized representative

to execute this Assignment.

HeartStent Corporation

By [Signature]
Name: DAVID H. MOWAT
Title: PRESIDENT, C.O.O.
Date _____

Percardia, Inc.

By _____
Name: _____
Title: _____
Date _____

IN TESTIMONY WHEREOF, each party has caused its authorized representative
to execute this Assignment.

HeartStent Corporation

By _____
Name: _____
Title: _____
Date _____

Percardia, Inc.

By Nancy B. [Signature]
Name: Nancy B. [Signature]
Title: President & CEO
Date: 10-24-03

PATENT SCHEDULEU.S. Patents and Patent Applications

Appln. Serial No.	Patent No.	Filing Date	Title
08/689,773	5,755,682	August 13, 1996	Method and apparatus for performing coronary artery bypass surgery
09/915,539	5,908,029	August 15, 1997	Coronary artery bypass with reverse flow
08/882,397	5,944,019	June 25, 1997	Closed chest coronary bypass
08/944,313	5,984,956	October 6, 1997	Transmyocardial implant
09/063,160	6,029,672	April 20, 1998	Transmyocardial implant procedure and tools
09/135,879	6,053,942	August 18, 1998	Transmyocardial implant with coronary stent
09/063,161	6,076,529	April 20, 1998	Transmyocardial implant with inserted vessel
09/055,488	6,093,166	April 3, 1998	Coronary bypass implant
09/246,596	6,102,941	February 8, 1999	Transmyocardial implant with coronary ingrowth
09/373,790	6,113,630	August 13, 1999	Transmyocardial implant with minimized coronary insertion
09/094,136	6,113,823	June 9, 1998	Pyrolytic carbon transmyocardial implant
09/054,815	6,123,682	April 3, 1998	Closed chest coronary bypass
09/145,843	6,139,541	September 2, 1998	Guide for transmyocardial implant
09/311,003	6,182,668	May 13, 1999	Transmyocardial implant with induced tissue flap
09/232,272	6,193,726	January 15, 1999	Insertion tool for transmyocardial implant
09/152,586	6,197,050	September 14, 1998	Transmyocardial implant with compliance collar
09/009,674	6,214,041	January 20, 1998	Transmyocardial implant with septal perfusion
09/179,711	6,223,752	October 27, 1998	Transmyocardial implant procedure
09/433,454	6,237,607	November 4, 1999	Transmyocardial implant procedure
09/009,400	6,250,305	January 20, 1998	Method for using a flexible transmyocardial implant
09/548,173	6,350,248	April 13, 2000	Expandable myocardial implant
09/548,175	6,361,519	April 13, 2000	Mesh tip myocardial implant
09/141,284	6,406,488	August 27, 1998	Healing transmyocardial implant
09/304,650	6,406,491	May 4, 1999	Compliant transmyocardial implant
09/304,730	6,409,697	May 4, 1999	Transmyocardial implant with forward flow bias

Appln. Serial No.	Patent No.	Filing Date	Title
09/793,318	6,454,760	February 26, 2001	Insertion tool for transmyocardial implant
09/326,819	6,454,794	June 7, 1999	Coronary bypass implant
09/686,689	6,582,463	October 11, 2000	Autoanastomosis
10/043,684		January 9, 2002	Coronary Bypass Implant
10/076,735		February 15, 2002	Transmyocardial Implant With Improved Flow
10/245,556		September 17, 2002	Coronary Bypass Implant
Cont. of 10/095,165		August 11, 2003	Healing Transmyocardial Implant
Cont. of 10/043,684		October 10, 2003	Coronary Bypass Implant
10/155,926		May 23, 2002	Transmyocardial Implant With Flow Reduction
09/975,746		October 10, 2001	Stabilized Transmyocardial Implant
10/439,344		May 15, 2003	Autoanastomosis
09/975,740		October 10, 2001	Flexible Transmyocardial Implant
09/931,655		August 16, 2001	Interventional Diagnostic Catheter and a Method for Using a Catheter To Access Artificial Cardiac Shunts
09/768,930		January 24, 2001	Autoanastomosis Device And Connection Technique
09/971,354		October 4, 2001	Multi-Lumen Implant
09/769,746		January 25, 2001	Intravascular Ventriculocoronary Artery Bypass Delivery Modalities
10/075,518		February 13, 2002	Cardiac Implant and Methods
10/023,314		December 14, 2001	Interventional Catheter With Three Dimensional Articulation
09/972,779		October 5, 2001	Transmyocardial Implant With Reinforcing Wrap
09/976,258		October 11, 2001	Medical Device With Enhanced Guide Capabilities
10/238,574		September 9, 2002	Device for Placing Transmyocardial Implant
10/153,341		May 21, 2002	Transmyocardial Implant Delivery System
10/052,156		January 16, 2002	Encased Implant and Methods
10/150,621		May 17, 2002	Transmyocardial Implant With Natural Vessel Graft and Method

Foreign Patents and Patent Applications

Country	Appln. Serial No.	Patent No.	Filing Date	Title
Australia	4057397	716771	August 12, 1997	Coronary Bypass Implant
Belgium	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Switzerland	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Germany	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Europe	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
France	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Great Britain	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Great Britain	97171169	2316322	August 12, 1997	Coronary Bypass Implant
Ireland	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Japan	9216550	2886847	August 11, 1997	Coronary Bypass Implant
Norway	990688	990688	August 12, 1997	Coronary Bypass Implant
New Zealand	334541	334541	August 12, 1997	Coronary Bypass Implant
Portugal	97938185.2	959815	August 12, 1997	Coronary Bypass Implant
Canada	2262623		August 12, 1997	Coronary Bypass Implant
Europe	02014488.7		August 12, 1997	Method and Apparatus for Performing Coronary Artery Bypass Surgery
Germany	199839255		November 10, 1999	Transmyocardial Implant With Coronary Ingrowth
Europe	98942170.6		August 20, 1998	Transmyocardial Implant
Europe	98965487.6		December 22, 1998	Transmyocardial Implant With Septal Perfusion
Canada	2341521		August 24, 1999	Transmyocardial Implant
Europe	99943852.6		August 24, 1999	Transmyocardial Implant
Japan	00567153		August 24, 1999	Transmyocardial Implant
Germany	100844502		March 27, 2000	Compliant Transmyocardial Implant
Japan	00614922		March 27, 2000	Compliant Transmyocardial Implant
PCT	PCT/US02/26226		August 15, 2002	Interventional Diagnostic Catheter and a Method for Using a Catheter to Access Artificial Cardiac Shunts
PCT	PCT/US02/31659		October 2, 2002	Transmyocardial Implant With Reinforcing Wrap